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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/811,711 | 03/29/2004 | Thomas K. Albanito | 04-106-A | 1442 |
| 32097 | 7590 | 08/12/2005 | EXAMINER | |
| LESAVICH HIGH-TECH LAW GROUP, P.C. SUITE 325 39 S. LASALLE STREET CHICAGO, IL 60603 | | | HAYES, BRET C | |
| | | | ART UNIT | PAPER NUMBER |
| | | / | 3644 | |

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/811,711 | ALBANITO ET AL. |
| | Examiner | Art Unit |
| | Bret C. Hayes | 3644 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 May 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 15-30,32 and 33 is/are allowed.
- 6) Claim(s) 1-14 and 31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>16DEC04, 11MAY05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plural electrical-conducting filaments and the plural heat removing filaments must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Allowable Subject Matter

2. The indicated allowability of claims 1 – 14 and 31 is withdrawn in view of the newly discovered reference(s) to US Patent Nos. 6,047,492 to Watson et al. (*Watson*) in view of 6,581,319 B2 to West. Rejections based on the newly cited reference(s) follow.

3. Further, because of the above newly discovered references, examiner amends the statement of reasons for allowability as follows.

4. Claims 15 – 30, 32 and 33 are allowed.

5. The following is an examiner's statement of reasons for allowance: the prior art of record neither discloses nor fairly teaches the recited limitations of the claimed invention including, but not limited to: the claimed combination including the lure body component including a plurality of electrical conducting filaments attached to the electronic circuit board for receiving current from the electronic circuit board.

6. This statement is not intended to necessarily state all the reasons for allowance or all the details why the claims are allowed and has not been written to specifically or impliedly state that all the reasons for allowance are set forth (MPEP 1302.14)..

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 – 14 and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Watson in view of West as cited by Applicant.

9. Re – claims 1 and 31, Watson discloses the invention substantially as claimed including a vibrating fishing lure, comprising in combination: a hooking means 441, for example; a lure body component, set forth at col. 2, lines 32 – 43, for example; an electronic circuit board 31, for example, with a vibrator, *inter alia* – 40, integral thereto; a power source 32, 34, for example, an on-off switch 423, for example; and, a containment component 397, for example, having the board 31, a first portion of the hooking means 441, best seen in Fig. 29, for example, and the power source 32, 34 contained in an internal waterproof portion therein, wherein the component 397 is contained within the lure body component , as set forth at col. 13, line 52, for example, “FIG. 29 illustrates an alternative structure in which a metallic hook 441 is included in the circuit 395 as a conductor to the switch contact 423. The shaft of the hook 441 may be embedded in to resin 431 along with the other components of the circuit 395.” Regarding the limitations that the vibrator 40 is integral to the board 31, and the component 397 is adhered to the lure body, Watson discloses the claimed invention except for this adhesion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the vibrator integral with the board, and adhere the component, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1983). Further, it has

been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973).

10. Watson discloses the claimed invention except for the board 31 having a preprogrammed microprocessor.

11. West teaches a programmed microprocessor 24 integral with an electronic circuit board, see claim 10, for example, in the same field of endeavor for the purpose of randomly operating a vibration in a fishing lure.

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Watson to include the programmed microprocessor as taught by West in order to randomly operate the vibration in the fishing lure.

13. Re – claim 2, Watson in view of West discloses the claimed invention as applied above, and, further, Watson discloses the hooking means 441 including a hooking means for a single hook with a single hooking portion, a single hook with a carabiner mechanism, a single hook with a plurality of hooking portions or a plurality of hooks, see Fig. 29, for example.

14. Re – claim 3, Watson in view of West discloses the claimed invention as applied above, and, further, Watson discloses the power source 32, 34 including a battery, a solar cell or a capacitor.

15. Re – claim 4, Watson in view of West discloses the claimed invention as applied above, Watson discloses the on-off switch being activated when immersed in water, except for the on-off switch including a toggle switch, a compression switch, a push switch, an optical switch, an infrared switch, a Bluetooth switch or a wireless switch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a toggle switch, a

compression switch, a push switch, an optical switch, an infrared switch, a Bluetooth switch or a wireless switch, since the equivalence of a water-activated switch and a toggle switch, a compression switch, a push switch, an optical switch, an infrared switch, a Bluetooth switch or a wireless switch for their use in the electronics art and the selection of any known equivalents to the water-activated switch would be within the level of ordinary skill in the art.

16. Re – claim 5, Watson in view of West discloses the claimed invention as applied above. Watson discloses the component 397 comprising plastic, silicon, rubber, fiberglass, composite, metal or wood material, as set forth at col. 13., lines 10 – 18, for example.

17. Re – claims 6 and 7, Watson in view of West discloses the claimed invention as applied above. However, while neither Watson nor West may explicitly disclose either: the materials comprising the lure body; or, the lure body including any of various bait-type forms or shapes, regarding claim 6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a preferred material from any well-known in the art at the time the invention was made, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (*In re Leshin*, 125 USPQ 416), and , regarding claim 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form or make the shape of the lure body any of various bait-type forms or shapes, since there is no invention in merely changing the shape or form of an article without changing its function except in a design patent (*Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23).

18. Re – claims 8 and 9, Watson in view of West discloses the claimed invention except for explicitly stating attachable appendages including tail, claw or leg appendages. Since bait-type

forms and shapes including the various kinds listed in claim 7, for example, are well-known types of bait in the art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make any of these bait types having appendages to be attachable (and, therefore, detachable), since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Examiner suggests reading col. 9, line 25 – col. 10, line 39, while contemplating the rejections of claims 5 – 9 above.

19. Re – claim 10, Watson in view of West discloses the claimed invention as applied above, and, further, Watson discloses the lure body 202, for example, including a plurality of connected body components, set forth at col. 9, lines 61 – 65, for example.

20. Re – claim 11, Watson in view of West discloses the claimed invention as applied above, and, further, Watson discloses making the operation means buoyant, col. 9, line 25, for example. Further, it is well known in the art to use floatation means as a way of controlling the depth to which a lure body will be able to sink.

21. Re – claim 12, Watson in view of West discloses the claimed invention as applied above. While neither Watson nor West may explicitly state such, it is also well known in the art to include sinkers or weights for similar reasoning to that set forth above as applied to claim 11, for example.

22. Re – claims 13 and 14, since Watson discloses intermittent operation, as at col. 1, lines 22 – 25, for example, being state of the art, whether that intermittency simulates a healthy or a diseased, distressed or dying organism would be a obvious matter to one having ordinary skill in

the art at the time the invention was made because it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

Conclusion

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

On July 15, 2005, the Central FAX Number will change to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and **571-273-8300** will be the only facsimile number recognized for "centralized delivery".

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu, can be reached at (571)272 – 7045. The fax number is (703) 872 – 9306.

bh

5-Aug-05



TERI PHAM LUU
SUPERVISORY
PRIMARY EXAMINER